

REMARKS

Rejection of claims 1-3, 6-11, and 14-18 under 35 U.S.C. § 103(a) as being unpatentable over US2002/0092019 (Marcus) in view of US6698020 (Zigmond)

Applicant respectfully traverses the rejection of claims 1-3, 6-11, and 14-18.

Applicant respectfully submits that the combination of Marcus and Zigmond does not teach or suggest all the claim limitations as set forth in independent claims 1, 9, and 17. For example, independent claim 1 recites “the first media data indicates at least one insertion point of the first media content,” which are not taught or suggested in the combination of Marcus and Zigmond.

The Office Action on page 3, item 3 states “Marcus does not teach the steps of the media content and the media data being transmitted separately.” In the Office Action, it is acknowledged that Marcus does not disclose this but that “Zigmond teaches wherein media content and media data associated with the media content is being transmitted separately (trigger reception, col. 15, lines 35-65, receiving video streams and associated data separately, Fig. 5).”

Zigmond discloses an advertisement insertion device that includes a switching decision unit, an advertisement repository, and a video switch. When the switching decision unit identifies the presence of a triggering signal received along with a video programming feed, it prompts the video switch to interrupt display of the video programming feed and to insert in its place the advertisement from an advertisement repository 86. See col. 15, lines 54-61 of Zigmond.

Applicant respectfully disagrees with the statement in item 3, page 3, of the Office Action dated September 4, 2008 that “Zigmond teaches wherein media content and media data associated with the media content is being transmitted separately (trigger reception, col. 15, lines 35-65, receiving video streams and associated data separately, Fig. 5).” It appears that the Office Action equates Applicant's "media data" with Zigmond's "triggering signal." This analogy is, however, a mischaracterization of Zigmond. In Zigmond, when switching decision unit identifies

the presence of a triggering signal, it prompts video switch to interrupt display of the video programming feed and to insert in its place the selected advertisement from advertisement repository. See col. 15, lines 56-61 of Zigmond. Also, in Zigmond, every time a triggering signal is received, the display of video programming feed is interrupted. Thus, it is clear that the triggering signal merely indicates to interrupt the display of the video programming feed, and does not indicate the insertion points of the video programming feed. In contrast, Applicant's claim recites "receiving, separately, a first media content and a first media data...the first media data indicates at least one insertion point of the first media content." Thus, it is inappropriate to equate Applicant's "media data" with Zigmond's "triggering signal." Therefore, Applicant requests to kindly withdraw the rejection.

Further, in Zigmond, the video switch merely interrupts display of the video programming feed, and inserts in its place the advertisement from the advertisement repository. Thus, it is clear that the video programming feed and the advertisement are not combined, but provided separately to the display (equated to Applicant's output device). In contrast, Applicant's claim recites "providing a combined media to an output device, wherein the combined media includes the first media content and at least a portion of the second media content inserted at the at least one insertion point of the first media content."

Therefore, the combination of Marcus and Zigmond does not teach or suggest the above mentioned claim limitations as required by independent claim 1, so the Applicant respectfully requests withdrawal of the rejection of claim 1 under 35 U.S.C 103.

Regarding independent claims 9, and 17, Applicant respectfully submits that the above discussed argument apply equally to the limitations of claims 9, and 17. Applicant therefore respectfully requests withdrawal of the rejection of claims 9, and 17 under 35 U.S.C 103.

Dependent claims 2-3, 6-8, and 10, 11, 14-16, and 18 depend from, and include all the limitations of independent claims 1, 9, and 17. Therefore, Applicant respectfully requests reconsideration of dependent claims 2-3, 6-8, and 10, 11, 14-16, and 18, and requests the withdrawal of the rejection.

Rejection of Claims 4-5, and 12-13 under 35 U.S.C. § 103(a) as being unpatentable over US 20020092019 (Marcus), in view of US6698020 (Zigmond) and in further view of US 7096488 (Zhang)

Zhang also does not address the deficiencies of Marcus and Zigmond namely “receiving, separately, a first media content and a first media data...the first media data indicates at least one insertion point of the first media content,” as recited in claims 1 and 9.

Because dependent claims 4-5, and 12-13 depend from, and include all the limitations of, independent claims 1 and 9, claims 4-5, and 12-13 are also not unpatentable under 35 U.S.C. § 103(a) in view of Marcus, Zigmond, and Zhang.

Conclusion

Applicant has reviewed the other references of record and believes that Applicant's claimed invention is patentably distinct and nonobvious over each reference taken alone or in combination. Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Such action is earnestly solicited by the Applicant. Should the Examiner have any questions, comments, or suggestions, the Examiner is invited to contact the Applicant's attorney or agent at the telephone number indicated below.

Please charge any fees that may be due to Deposit Account 502117, Motorola, Inc.

Respectfully submitted,

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